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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/994,661	11/28/2001	Kurt Graber	111113	8433

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EXAMINER

TAWFIK, SAMEH

ART UNIT PAPER NUMBER

3721

DATE MAILED: 03/18/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

NK

Office Action Summary

Application No.

09/994,661

Applicant(s)

GRABER ET AL.

Examiner

Sameh H. Tawfik

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) 11-17 is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-10 and 18 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some * c) ☐ None of:
- ☒ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>6-8</u> . | 6) <input type="checkbox"/> Other: . |

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DETAILED ACTION

Election/Restrictions

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-10 and 18, drawn to a method of producing a newspaper, classified in class 493, subclass 413.
- II. Claims 11-17, drawn to an apparatus for producing a newspaper, classified in class 493, subclass 421.

The inventions are distinct, each from the other because of the following reasons:

Inventions Group I and Group II are related as process and apparatus for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. (MPEP § 806.05(e)). In this case the process as claimed can be practiced by another materially different apparatus such as one without feed and depositing apparatus nor a removal apparatus.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

During a telephone conversation with Mr. David Cho Reg. Number 48078 on 11/26/2002 a provisional election was made with traverse to prosecute the invention of Group I, claims 1-10

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and 18. Affirmation of this election must be made by applicant in replying to this Office action.

Claims 11-17 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Priority

Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Specification

The abstract of the disclosure is objected to because applicants need to amend the abstract as follow:

(lines 2 and 3) delete “,and an apparatus implements the method”. Correction is required. See MPEP § 608.01(b).

The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed. For example “Method for producing a newspaper”.

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The disclosure is objected to because of the following informalities: applicants can not refer to claim numbers on the specification of the invention. For example (specification, page 2, line 23) "...features of claim 1,...." is improper phrase.

Appropriate correction is required.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-10 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wolf (2,361,140) in view of Dixon et al. (2,699,936).

Wolf discloses a method of producing a newspaper which comprises one section which is formed at least from one centrally folded printed sheet (Fig. 5); the method comprising the steps of feeding individual sequentially printed sheets (Figs. 1 and 5; column 1, lines 39-44), which are intended for forming the individual sections (Fig. 5) of the newspaper, continuously to a first collecting station and the sheets which are assigned to one common section are positioned one above the other to form a sheet stack (Figs. 1-5); folding the finished sheet stack in order to produce the sections of the newspaper (Figs. 1 and 5); repeating these steps until of the newspaper have been completed and positioned one upon the other (Figs. 1-5). Wolf does not disclose the exact steps of conveying the finished sheet stack away from the first collecting station nor the step of depositing the section in a second collecting station. However, Dixon

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discloses the steps of conveying the finished sheet stack away from the first collecting station (Fig. 2) and the step of depositing the section in a second collecting station (Figs. 3-5).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have modified Wolf's method of producing a newspaper by having the steps of conveying the finished sheet stack away from the first collecting station nor the step of depositing the section in a second collecting station, as suggested by Dixon, in order to provide a novel method in which the successive folding and transferring operations may be effected automatically and by simple mechanical means while retaining positive control over the sheet at all times to insure uniformity in the final package (column 1, lines 20-25).

Regarding claim 2: Wolf discloses individual sections of the newspaper are printed by a printing machine (column 1, lines 39-44). Wolf does not disclose exactly that the printer is a digital printing machine. However, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have modified Wolf's method by having the printer is a digital printing machine, as a matter of engineering design choice, since the examiner takes an official notice that the mentioned digital printing machine is old, well known, and available in the art.

Regarding claim 3: Wolf discloses that the section stack is folded in the center (Fig. 5).

Regarding claims 4-6: Wolf discloses that the sheets of the sheet stack are releaseably connected to one another in order to be conveyed away (Figs. 1-5); and printed product is fed to the collecting station and positioned on the newspaper sections (Fig. 5).

Regarding claim 7: Wolf does not exactly discloses that the sheets of a width of from 420 to 508 cm and of a length of from 580 to 760 cm. However, it would have been obvious to one

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having ordinary skill in the art at the time the invention was made to have modified Wolf's method by having the sheets of a width of from 420 to 508 cm and of a length of from 580 to 760 cm, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. In re Aller, 105 USPQ 233.

Regarding claim 8: Wolf nor Dixon disclose that the finished sheet stack is conveyed away from the first collecting station at a speed which is greater than the speed of the sheets fed to the first collecting station. However, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have modified Wolf's method by having conveyor downstream from each other and being speed with different velocity to convey the finished sheet stack from the first collecting station at a speed which is greater than the speed of the sheets fed to the first collecting station, as a matter of engineering design choice, since the examiner takes an official notice that conveying product or stacks with different velocity within a machine is old, well known, and available in the art.

Regarding claim 9: Wolf does not disclose that the sheet is braked before being deposited in the first collecting station. However, Dixon discloses that the sheet is braked before being deposited in the first collecting station (Fig. 2).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have modified Wolf's method of producing a newspaper by having the steps of braking the sheet before being deposited in the first collecting station, as suggested by Dixon, in order to provide a novel method in which the successive folding and transferring operations may be effected automatically and by simple mechanical means while retaining

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positive control over the sheet at all times to insure uniformity in the final package (column 1, lines 20-25).

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Kober 4073486 and Pemberton 4279409 disclose different method of folding and producing newspaper.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sameh H. Tawfik whose telephone number is (703) 308-2809. The examiner can normally be reached on Tuesday - Friday from 8:00 AM to 6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rinaldi Rada can be reached on (703) 308-2187. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-3579 for regular communications and (703) 308-7769 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1148.

ST.
March 12, 2003



EUGENE KIM
PRIMARY EXAMINER